

REMARKS

In response to the Office Action mailed July 13, 2006, and in view of the request for continued examination (RCE) filed concurrently herewith, Applicants respectfully request reconsideration. Claims 35-46 were previously pending for examination. Claims 35-38 have been amended herein. New claim 47 has been added. As a result, claims 35-47 are pending for examination, with claim 35 being the sole independent claim. No new matter has been added.

Double Patenting Rejections

Claims 35-45 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over specified claims of U.S. Patent Nos. 6,406,036, 6,088,722, 6,020,883, 5,838,087, 5,754,939, 5,754,938. Applicants respectfully disagree, as each of claims 35-45 are patentably distinct from each of the claims recited in each of the above patents.

Furthermore, the double patenting rejections are improper because the Office Action has not set forth any rationale as to why the claims at issue are not patentably distinct from those of the referenced patents. The Office Action states that the claims at issue are "all directed to personalizing user content information by generating and correlating target profile and user target profile interest summary [sic]." Assuming for the sake of argument that this is true, the fact that claims relate to a common technical realm does not mean that they are patentably indistinct from one another. Such a general assertion is not sufficient to support a double patenting rejection. MPEP 804 states:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application;
and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of the invention defined in a claim in the patent.

The statement that “since there is large number of claims in each patent, mapping of limitations in each claim is not deemed productive” only highlights the Office’s conscious failure to comply with the MPEP procedure. The Office Action has not provided any rationale in support of the double patenting rejections other than the assertion that the claims relate a common technical realm. The amount of work required to justify the rejection – if it is justifiable – is no excuse. If no further rationale exists to support the rejections, such rejections should be withdrawn.

Further, claims 35-40 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of co-pending Application No. 10/262,123. Applicants note that these rejections are provisional and therefore do not require a response at this time. Until the claims are otherwise deemed allowable, it is premature to address these provisional rejections. Applicants expressly reserve the right to respond to these rejections at a future time.

Rejections under 35 U.S.C. §112

The Office Action rejected claim 46 because it (incorrectly referred to as claim 45 in the Office Action) purportedly depends on claim 1544, which does not exist. The Office Action is correct only to the extent that the listing of claims in the Amendment of April 10, 2006 incorrectly indicates that claim 46 depends from claim 1544, but that dependency is not listed as an amendment so the dependency remains to claim 44 and the above listing of claims is correct. It is believed no amendment is required but if the Office requires the formality of an amendment, the Examiner is hereby authorized to correct the dependency by Examiner’s Amendment.

Rejections under 35 U.S.C. §103

The Office Action rejected claims 35-46 under 35 U.S.C. §103(a) as purportedly being unpatentable over U.S. Patent No. 5,717,923 (Dedrick). Applicants respectfully traverse these rejections.

1. Discussion of Dedrick

Dedrick is directed to dynamically customizing electronic information to individual end users. A personal profile database in a client system stores consumer information corresponding to individual end users of the client system. The client system includes a content adapter that compares electronic information received by the client system to the consumer information in the personal profile database and customizes the electronic information to an individual end user based on this comparison. (Col. 2, lines 1-11).

The system includes a publisher-advertiser 18 with software tools to create electronic information which includes content and advertisements that can be transmitted over the system. The electronic information may allow an end user to access a content database, or the information may be all or a portion of a content database. The content database may be the text and video of an electronic newspaper. (col. 4, lines 11-17). The publisher-advertiser 18 is provided with software tools to create electronic information in a wide variety of consumption formats that can be transmitted over the system. These consumption formats include formats such as audio, video, graphics, animation, texts, etc. (col. 4, lines 44-48). The publisher-advertiser 18 may be provided with a software tool to embed consumer variables in the electronic variables, to be enable monitoring of consumer interaction with the electronic information. (Col. 4, lines 24-29.). "Consumer variables" include demographic and psychographic information about consumers, including vital statistics, age, sex, marital status, income, likes, dislikes, lifestyle and behavioral characteristics, personality traits and preferences, etc. (Col. 3, lines 42-56).

2. The Claims Distinguish over Dedrick

Claim 35 patentably distinguishes over Dedrick because Dedrick does not disclose or suggest a method that includes all of the limitations recited in claim 35 for providing a user with access to selected ones of a plurality of target objects.

A. Dedrick Does Not Disclose or Suggest "Automatically Generating Target Profiles for Target Objects."

Dedrick does not disclose or suggest “automatically generating target profiles for target objects that are stored in said electronic storage media, each of said target profiles being generated from the contents of an associated one of said target objects and their associated sets of target object characteristics,” as required by claim 35. Dedrick does not even disclose the concept of a target profile. The Office Action suggests that “target objects are identified and managed by target object characteristics (4:23-43, 6:35-42, 11:46-61).” Applicants respectfully disagree because the passages of Dedrick cited in the Office Action do not support this assertion.

The cited passages of Dedrick describe embedding consumer variables within the electronic information (as described in col. 4 of Dedrick), which is not the same as generating target profiles from the content of the electronic information and associated sets of characteristics of the information. Rather, as is made clear throughout Dedrick, in particular in column 3 cited above, consumer variables are based on consumers, specifically demographic and psychographic information about consumers, not content of the electronic information. The consumer variables allow advertisements to be customized to particular types of users. For example, the color of an advertisement may be set to be variable such that the user’s system displays the user’s advertisement in the color that the user prefers. If the user prefers the color green, the user’s terminal may change the color of the advertisement to be green. (Col. 6, lines 35-42). Thus, in Dedrick’s system, even the color of the advertisement is not an inherent property of the advertisement itself. Quite to the contrary, the color is changed based on a particular user to suit the user’s preference. Therefore, Dedrick’s “consumer variables” are not “target object profiles” because they are characteristics of consumers, rather than objects.

Furthermore, claim 35 requires that the “target object profiles” be generated from the contents of an associated one of said target objects and their associated sets of target object characteristics. Again, Dedrick’s “consumer variables” are not generated from the contents of a target object or the associated sets of target object characteristics. Rather, the “consumer variables” are descriptive of consumers, not Dedrick’s advertisements. An advertisement itself does not have characteristics such as age, sex, marital status or income level, because advertisements are not people. Since Dedrick’s “consumer variables” are attributes of human beings, it is unclear how such personal attributes could possibly be generated from the content of an advertisement.

Even if one could consider “consumer variables” to be “target object profiles,” the limitations of claim 35 would still not be met because claim 35 requires that the target object profiles be generated automatically. By contrast, Dedrick states: “a publisher/advertiser 18 is provided with a GUI which allows the publisher/advertiser 18 to select certain consumer variables.” (Col. 4, lines 33-35). Therefore, Dedrick’s “consumer variables” are entered manually. Manual entry of consumer variables (such as age, sex, marital status, income etc.) using a graphical user interface (GUI) is not automatic generation of these parameters.

B. Dedrick Does Not Disclose or Suggest “Automatically Generating at least one User Target Profile Interest Summary.”

The Office Action appears to suggest that Dedrick describes automatically generating at least one user target profile interest summary because Dedrick describes updating of user profiles when a user views an advertisement. Applicants respectfully disagree that Dedrick discloses this claim limitation. Dedrick states that the user manually enters the consumer variables using a graphical user interface. (Col. 3, lines 37 – 67). Again, manual entry of data is not automatic generation of data. Claim 35 distinguishes over Dedrick because claim 35 recites “automatically generating at least one user target profile interest summary.” Even if Dedrick describes updating of consumer variables, automatic generation of data is not the same as updating data.

C. Dedrick Does Not Disclose or Suggest Either Steps (f)(1) or (f)(2).

Claim 35 recites, *inter alia*:

(f) wherein said step of providing access comprises at least one of the following transmission steps:

(1) transmitting data, in response to said identified user activating a one of said user terminals to identify said selected item on said list, indicative of said identified user's selection of said selected item from said one user terminal to said target server via a one of said data communication connections;

(2) transmitting at least one of said identified ones of said plurality of target objects, to said identified user in advance of said user selecting said at least one of said identified ones of said plurality of target objects.

Dedrick does not teach or suggest step (f) of claim 35 because Dedrick does not describe performing either steps (f)(1) or (f)(2). The Office Action states that Dedrick allows a user to select and retrieve desired target objects. "Thus, there is a selection signal transmitted from the user terminal to the server." (Page 7 of the Office Action). Applicants respectfully disagree. Contrary to the characterization in the Office Action, Dedrick makes no mention of such a selection signal. Dedrick merely states that a user can select which advertisement to consume. (Col. 9, lines 15-25). Although Dedrick does not elaborate on what is meant by "selecting which advertisement to consume," the Office Action appears to assume that Dedrick's statement implies all the limitations of step (f) above. In fact, Dedrick appears to be completely silent with respect to the limitations of step (f).

In view of the foregoing, claim 35 patently distinguishes over Dedrick. Accordingly, the rejection of claim 35 under §103(a) should be withdrawn.

Claims 36-47 each depend from claim 35 and are therefore patentable for at least the same reasons. Accordingly, the rejections of these claims also should be withdrawn.

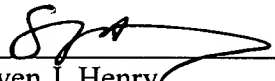
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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Respectfully submitted,

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